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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,273	07/17/2003	Yumiko Kikuoka	59614 (49381)	4208

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EDWARDS ANGELL PALMER & DODGE LLP  
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BOSTON, MA 02205

EXAMINER
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DICKER, DENNIS T

ART UNIT	PAPER NUMBER
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2625

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10/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/622,273	<b>Applicant(s)</b> KIKUOKA, YUMIKO	
	<b>Examiner</b> Dennis Dicker	<b>Art Unit</b> 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 12, 14, 17, 18, 25, 27-30, 32, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 2-4, 6-11 and 19-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments, see Applicant, filed 7/30/2007 with respect to the rejection(s) of claim(s) 1,5 12-18 and 25-30 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Morris (hereinafter "Morris '075" 7,028,075).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 12, 14, 25, 27, 32, 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Morris '075" 7,028,075.

As pertaining to claim 1, Morris '075 teaches An image information distributing method for receiving image information stored in a central apparatus by one or a plurality of terminal apparatus (i.e., **Col. 3 Lines 2-11, first computer sends images, stores images, and email request on server then server transmits email to second computer**), comprising the steps of: generating, by using said image information stored in said central apparatus (i.e., **Col. 4 Lines 16-18, photomail server strips and stores**

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**the images)**, summary image information whose information amount is smaller than said image information (**i.e., Col 4 Lines 18-29, a link to the images**); generating a summary document including location information indicative of a location in which said image information is stored and said summary image information (**i.e., Col. 7 Lines 67-Col 8 Lines 5 , Photomail server generates an html based email message with attached links to the images**) generating a summary E-mail by attaching said generated summary document to an E-mail; and (**i.e., Col. 4 Lines 58-68, standard email message includes a body and a place to attach the selected images** ); transmitting said generated summary E-mail to said one or a plurality of terminal apparatus (**i.e., Col. 3 Lines 9-11, transmits email and message to the second user**).

As pertaining to claim 12, Morris '075 teaches a central apparatus having means for, by connecting to communicating means, performing communication, and storing means for storing image information received via said means (**i.e., Col. 4 Lines 16-18, photomail server strips and stores the images**), comprising: means for, when a transmitting instruction including location information is received, transmitting the image information stored in a location in said storing means indicated by the location information included in the received transmitting instruction (**i.e., Col 4 Lines 18-29, a link to the images where when link is pressed images are displayed**); summary document generating means having means for, by using received image information, generating summary image information whose information amount is smaller than said image information (**i.e., Col. 4 Lines 16-18, photomail server strips and stores the**

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**images)** and means for generating a summary document including location information indicative of a location in said storing means in which said image information is stored and the generated summary image information (i.e., **Col. 7 Lines 67- Col 8 Lines 5 , Photomail server generates an html based email message with attached links to the images)**); and E-mail processing means having means for generating a summary E-mail by attaching the generated summary document to E-mail. (i.e., **Col. 4 Lines 58-68, standards email message includes a body and a place to attach the selected images )**, and means for transmitting the generated summary E-mail (i.e., **Col. 4 Lines 16-19 , sends standard email message with links to images.**

As pertaining to claim 14, Morris '075 teaches a terminal apparatus (i.e., **12 of Fig 1 and Col 3. Lines 61-66, Computer running an photomail application)** having means for, by connecting to communicating means performing communication (i.e., **Col 3. lines 66-67 , Computer communicates over a network )**, comprising: means for receiving image information i.e., **Col. 3 Lines 2-11, server receives images)**; summary document generating means having means for, by using the received image information, generating summary image information whose information amount is smaller than said image information (i.e., **Col. 4 Lines 16-18, photomail server strips and stores the images)**, and means for generating a summary document including location information indicative of a location in which said image information is stored (i.e., **Col 4 Lines 18-29, a link to the images)**; and said summary image information; and E-mail processing means having means for generating a summary E-mail by attaching the generated summary document to an E-mail (i.e., **Col. 7 Lines 67- Col 8**

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**Lines 5 , Photomail server generates an html based email message with attached links to the images), and means for transmitting the generated summary E-mail (i.e., Col. 3 Lines 9-11, transmits email and message to the second user).**

As pertaining to claim 25 , Morris '075 teaches a central apparatus (i.e., 2 of Fig. 1 , **photomail server**) having means for, by connecting to communicating means, performing communication (i.e., 11 of Fig. 1 and Col. 3 Lines 66-67, **Communication over a network**), and storing means for storing image information received via said means (i.e., Col. 4 Lines 16-18, **photomail server strips and stores the images**), comprising a processor capable of performing operations (i.e., Col. 4 Lines 16-18, **photomail server process images**) of : when a transmitting instruction including location information is received (i.e., Col. 4 Line 66-Col. 5 Line 2 ,**First user sends image and instructions to photomail server** ), transmitting image information stored in a location in said storing means indicated by the location information included in the received transmitting instruction (i.e., Col. 5 Lines 19 -22, **transmits image information to the indicated recipient**); generating, by using received image information, summary image information whose information amount is smaller than said image (i.e., Col.5 Lines 14-19, **Image information is stored, resized and stored in an album which is put in an email** ); generating a summary document including location information indicative of a location in said storing means in which said image information is stored (i.e., Col.5 Lines 34-36, **server inserts a link or URL to the images**); and the generated summary image information; generating a summary E-mail by attaching the generated summary document to an E- mail (i.e., Col. 7 Lines 67- Col

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**8 Lines 5 , Photomail server generates an html based email message with attached links to the images);; and transmitting the generated summary E-mail (i.e., Col. 3 Lines 9-11, transmits email and message to the second user).**

As pertaining to claim 27, Morris '075 teaches a terminal apparatus (i.e., 12 of Fig 1 and Col 3. Lines 61-66, Computer running an photomail application) having means for, by connecting to communicating means, performing communication (i.e., 11 of Fig. 1 and Col. 3 Lines 66-67, Communication over a network), comprising a processor capable of performing operations (i.e., Col. 4 Lines 16-18, photomail server process images) of: receiving image information (i.e., Col. 3 Lines 2-11, server receives images); generating, by using received image information, summary image information whose information amount is smaller than said image information (i.e., Col.5 Lines 14-19, Image information is stored, resized and stored in an album which is put in an email ); generating a summary document including location information indicative of a location in said storing means in which said image information is stored and said summary image information (i.e., Col. 5 Lines 34-36, server inserts a link or URL to the images ).

As pertaining to claim 32, Morris '075 teaches a computer program embodied in a computer-readable medium for causing a computer to transmit/receive information is recorded (i.e., Col 10 Lines 24-29, Computer readable medium for storing a program for sharing digital images), said computer comprising means for, by connecting to communicating means, performing communication (i.e., Col 10 Lines 30-31 , Communicate over network ), said computer program comprising the steps for:

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causing the computer to receive image **information (i.e., Col 10 Line 43, Server receives email request with images)**; causing the computer to generate, by using the received image information, summary image information whose information amount is smaller than said image information **(i.e., Col 11 Lines 9-13, Server creates an album of scaled versions of images with links to originals )**; causing the computer to generate a summary document including location information indicative of a location in which said image information is stored and said summary image information **(i.e., Col 10 lines 44-47 , Created web album has links to original images stored on server )**; causing the computer to generate a summary E-mail by attaching the generated summary document to an E-mail; and causing the computer to transmit the generated summary E-mail **(i.e., Col 11 Lines 9-13, Server sends email with links to second computer)**.

As pertaining to Claim 34, Morris '075 teaches the terminal apparatus having displaying means **(i.e., Col. 5 Lines 36-37, Recipient views images)**, comprising summary document processing means for displaying onto said displaying means said summary image information included in a summary document **(i.e., Col. 4 Lines 17-19, Recipient computer displays summary of links to images)** which includes summary image information and/or character information and location information corresponding to image information **(i.e., Col. 4 Lines 17-19, Links designate location of original )**.

As pertaining to Claim 35, Morris '075 teaches the terminal apparatus further comprising means for, by connecting to communicating means, performing communication **(i.e., 11 of Fig. 1 and Col. 3 Lines 66-67, Communication over a**



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**network)**, wherein said summary document processing means comprises: means for accepting input of a receiving instruction for requesting reception of image information **(i.e., Col 4 Lines 19-22, Email includes links to images which can be activated by a click)**; and means for, when said receiving instruction is inputted, transmitting a transmitting instruction including the location information corresponding to the image information requested to be received **(i.e., Col 4 Lines 21-24, When links are activated original image is displayed on recipient screen)**.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 17-18, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris '075 in view of Lo et al. (hereinafter "Lo '001" 6,425,001).

With respect to Claim 5, Morris '075 teaches an image information distributing system wherein any of said scanner apparatus, said central apparatus and said terminal apparatus **(i.e., Col. 3 Lines 2-11, first computer sends images, stores images, and email request on server then server transmits email to second computer)** comprises: summary document generating means having means for generating, by

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using said image information generated by said scanner apparatus (**i.e., Col. 4 Lines 16-18, photomail server strips and stores the images**), summary image information whose information amount is smaller than said image information (**i.e., Col 4 Lines 18-29, a link to the images**), and means for generating a summary document including location information indicative of a location in which said image information generated by said scanner apparatus is stored and said summary image information (**i.e., Col. 7 Lines 67- Col 8 Lines 5 , Photomail server generates an html based email message with attached links to the images**); and E-mail processing means having means for generating a summary E-mail by attaching said generated summary document to an E-mail (**i.e., Col. 4 Lines 58-68, standards email message includes a body and a place to attach the selected images**), and means for transmitting the generated summary E-mail to said terminal apparatus (**i.e., Col. 3 Lines 9-11, transmits email and message to the second user**).

Morris '075 does not teach an image information distributing system in which a scanner apparatus for generating image information by reading an image of an original and transmitting said image information, a central apparatus for receiving and storing the image information transmitted from said scanner apparatus, and one or a plurality of terminal apparatus for receiving the image information transmitted from said central apparatus are connected via communicating means.

However, the mentioned claimed limitations are well known in the art as evidenced by Lo '001, In particular, Lo '001 teaches the use of an image information distributing system in which a scanner apparatus for generating image information by

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reading an image of an original and transmitting said image information (i.e., **Col 3. Line 51-54, Original image is scanned and digital image is generated**), a central apparatus for receiving and storing the image information transmitted from said scanner apparatus (i.e., **Col. 3 Lines 55-59, scanner sends digital data to scanner server where it is received and stored**), and one or a plurality of terminal apparatus for receiving the image information transmitted from said central apparatus are connected via communicating means (i.e., **Col. 3 Lines 56-57, Client computer received the transmitted image file** ),

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image information distributing system of Morris '075 as taught by Lo '001 since Lo '001 suggested in Col. 3 Lines 33-36 that such a modification would permit a scanned image to be locally stored on a network drive for easy access.

With respect to Claim 17, Morris '075 does teaches a apparatus comprising: summary document generating means having means for, by using the received image information, generating summary image information whose information amount is smaller than said image information (i.e., **Col. 4 Lines 16-18, photomail server strips and stores the images**), and means for generating a summary document including location information indicative of a location in which said image information is stored (i.e., **Col 4 Lines 18-29, a link to the images**); and said summary image information; and E-mail processing means having means for generating a summary E-mail by attaching the generated summary document to an E-mail (i.e., **Col. 7 Lines 67- Col 8**

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**Lines 5 , Photomail server generates an html based email message with attached links to the images), and means for transmitting the generated summary E-mail (i.e., Col. 3 Lines 9-11, transmits email and message to the second user).**

Morris '075 does not explicitly teach scanner apparatus having means for, by connecting to communicating means, performing communication, generating image information by reading an image of an original, transmitting the image information via said means.

However, the mentioned claimed limitations are well known in the art as evidenced by Lo '001, In particular, Lo '001 teaches the use of a scanner apparatus having means for, by connecting to communicating means, performing communication, generating image information by reading an image of an original (i.e., **Col 3. Line 51-54, Original image is scanned and digital image is generated**), transmitting the image information via said means (i.e., **Col. 3 Lines 55-59, scanner sends digital data to scanner server where it is received and stored**),

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image information distributing system of Morris '075 as taught by Lo '001 since Lo '001 suggested in Col. 3 Lines 33-36 that such a modification would permit a scanned image to be locally stored on a network drive for easy access.

With respect to Claim 18, Morris '075 teaches an image information distributing system wherein said scanner apparatus, said central apparatus and said terminal apparatus comprises processors, and any of the processors is capable of performing

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operations of: generating, by using image information generated by said scanner apparatus (i.e., Col. 7 Lines 67- Col 8 Lines 5, **Photomail server generates an html based email message with attached links to the images**); summary image information whose information amount is smaller than said image information (i.e., Col. 4 Lines 16-18, **photomail server strips and stores the images**); generating a summary document including location information indicative of a location in which said image information generated by said scanner apparatus is stored and said summary image information (i.e., Col 4 Lines 18-29, **a link to the images**); generating a summary E-mail by attaching the generated summary document to an E- mail (i.e., Col. 7 Lines 67- Col 8 Lines 5 , **Photomail server generates an html based email message with attached links to the images**); and transmitting the generated summary E-mail to said terminal apparatus mail (i.e., Col. 4 Lines 58-68, **standards email message includes a body and a place to attach the selected images**).

Morris '075 does not explicitly teach an image information distributing system in which a scanner apparatus for generating image information by reading an image of an original and transmitting said image information, a central apparatus for receiving and storing the image information transmitted from the image information transmitted from said central apparatus are connected via communicating means.

However, the mentioned claimed limitations are well known in the art as evidenced by Lo '001, In particular, Lo '001 teaches the use of an image information distributing system in which a scanner apparatus for generating image information by reading an image of an original and transmitting said image information (i.e., Col 3.

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**Line 51-54, Original image is scanned and digital image is generated)**, a central apparatus for receiving and storing the image information transmitted from the image information transmitted from said central apparatus (**i.e., Col. 3 Lines 55-59, scanner sends digital data to scanner server where it is received and stored**) are connected via communicating means (**i.e., 140 of Fig. 2, bus or cable**),

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image information distributing system of Morris '075 as taught by Lo '001 since Lo '001 suggested in Col. 3 Lines 33-36 that such a modification would permit a scanned image to be locally stored on a network drive for easy access.

With respect to claim 28, Morris '075 teaches The terminal having displaying means (**i.e., Col. 5 Lines 36-37, Recipient views images**), comprising a processor capable of performing operation of displaying onto said displaying means summary image information included in a summary document which includes summary image information (**i.e., Col. 4 Lines 17-19, Recipient computer displays summary of links to images**) and location information corresponding to image information (**i.e., Col. 4 Lines 17-19, Links designate location of original images** ).

With respect to claim 29, Morris '075 teaches the terminal further comprising means for, by connecting to communicating means, performing communication (**i.e., 11 of Fig. 1 and Col. 3 Lines 66-67, Communication over a network**), wherein said operation further includes operations of: accepting input of a receiving instruction for requesting reception of image information (**i.e., Col 4 Lines 19-22, Email includes**

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**links to images which can be activated by a click); and when said receiving instruction is inputted, transmitting a transmitting instruction including the location information corresponding to image information requested to be received (i.e., Col 4 Lines 21-24, When links are activated original image is displayed on recipient screen).**

With respect to Claim 30, Morris '075 teaches a processor capable of performing the operations of generating (i.e., Col. 4 Lines 16-18, **photomail server process images**), by using said image information, summary image information whose information amount is smaller than said image information (i.e., Col 4 Lines 18-29, **a link to the images**); generating a summary document including location information indicative of a location in which said image information is stored information (i.e., Col. 7 Lines 67- Col 8 Lines 5 , **Photomail server generates an html based email message with attached links to the images**) and said summary image information; generating a summary E-mail by attaching the generated summary document to an E-mail (i.e., Col. 4 Lines 58-68, **standards email message includes a body and a place to attach the selected images**); and transmitting the generated summary E-mail (i.e., Col. 3 Lines 9-11, **transmits email and message to the second user**).

Morris '075 does not explicitly teach a scanner apparatus having means for, by connecting to communicating means, performing communication, generating image information by reading an image of an original, transmitting the image information via said means.

However, the mentioned claimed limitations are well known in the art as evidenced by Lo '001, In particular, Lo '001 teaches the use of a scanner apparatus **(i.e., 144 of Fig. 2, Scanner)** having means for, by connecting to communicating means **(i.e., 140 of Fig. 2, bus or cable)** , performing communication, generating image information by reading an image of an original **(i.e., Col 3. Line 51-54, Original image is scanned and digital image is generated)**, transmitting the image information via said means **(i.e., Col. 3 Lines 55-59, scanner sends digital data to scanner server where it is received and stored)**.

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image information distributing system of Morris '075 as taught by Lo '001 since Lo '001 suggested in Col. 3 Lines 33-36 that such a modification would permit a scanned image to be locally stored on a network drive for easy access.

#### ***Allowable Subject Matter***

6. Claim 2-4, 6-11 and 19-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the references, either singularly or in combination, teach or fairly suggest an image information distributing system and associated with it method, wherein the method includes steps of determining whether character information is included in image information or not; and in the case where character information



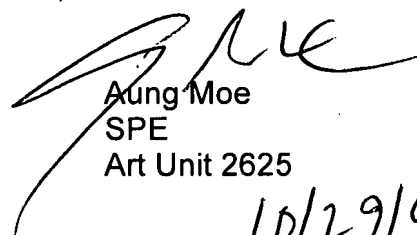
included in the image information, making the character information to be included in the summary document.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Dicker whose telephone number is (571) 270-3140. The examiner can normally be reached on Monday -Friday 7:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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